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REISSUE #4

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application for U.S.

Examiner: Not yet assigned

Patent No.: 5,498,240

Group Art Unit: 3306

Issued: September 10, 1996

Docket No.: 22965-2111

Inventors: Bagaoisan *et al.*

Serial No.: 08/843,711

Filed: April 16, 1997

For: **INTRAVASCULAR CATHETER WITH  
A REPLACEABLE SHAFT SECTION****RESPONSE TO NOTICE TO FILE  
MISSING PARTS OF APPLICATION**

## BOX MISSING PARTS

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to the Notice to File Missing Parts of Application - Filing Date Granted mailed July 29, 1997, transmitted herewith is Part 2 of the Notice to File Missing Parts of Application - Filing Date Granted; Declaration and Power of Attorney; Petition for Filing By Other Than All Inventors, under 37 C.F.R. § 1.47(a); Declaration of Nita Miller; Assent of Assignee to Reissue Application; and a return postcard.

Applicant is other than a small entity. Applicant hereby petitions for an Extension of Time of four (4) months, pursuant to 37 C.F.R. § 1.136(a).

Payment of Fees. Please charge the following fees to Deposit Account No. 08-1641, referencing Docket No. 22965-2111. The Commissioner is authorized to charge any additional fees and credit any overpayment which may be required in connection with this application to Deposit Account No. 08-1641, referencing Docket No. 22965-2111.

Extension Fee under 37 C.F.R. § 1.17(d)	\$1,510.00
Surcharge fee under 37 C.F.R. § 1.27	130.00
Petition Fee under 37 C.F.R. § 1.17(h)	130.00
<b>TOTAL FEES:</b>	<b>\$1,770.00</b>


Respectfully submitted,

By: William B. Anderson  
Reg. No. P41,585HELLER EHRMAN WHITE & McAULIFFE  
525 University Avenue  
Palo Alto, CA 94301-1900  
Direct Dial: (650) 324-7127  
Fax: (650) 324-0638

EJL:PM:njm

**CERTIFICATE OF MAILING**

I hereby certify that these papers are being deposited in the U.S. mail as first class with postage prepaid, addressed to: BOX MISSING PARTS, Assistant Commissioner for Patents, Washington D.C. 20231, on January 29, 1998, in Palo Alto, CA.





REISSUE #4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application for	)	Examiner: Not yet assigned
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Patent No.: 5,498,240	)	Group Art Unit: 3306
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Issued: September 10, 1996	)	
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Inventors: Bagaoisan, <i>et al.</i>	)	
	)	
Serial No.: 08/843,711	)	
	)	
For: <b>INTRAVASCULAR CATHETER WITH</b>	)	
<b>A REPLACEABLE SHAFT SECTION</b>	)	
	)	
Filed: April 16, 1997	)	
	)	
Docket No.: 22965.2111	)	

**DECLARATION PURSUANT TO 37 C.F.R. § 1.175**  
**AND POWER OF ATTORNEY**

Assistant Commissioner for Patents  
BOX REISSUE  
United States Patent and Trademark Office  
Washington, D.C. 20231

Dear Sir:

I depose and say that:

1. My residence, post office address and citizenship is as stated below  
next to my name.

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2. I believe that I am an original, first and joint inventor of the subject matter which is claimed and for which a patent on the invention entitled **INTRAVASCULAR CATHETER WITH A REPLACEABLE SHAFT SECTION**, was granted on March 12, 1996 as U.S. Patent No. 5,498,240 ('240 patent), a copy of which is attached as Exhibit A.

3. I have reviewed and understand the contents of the specification of the '240 patent, including the claims.

4. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

5. I believe the '240 patent to be partly inoperative or invalid because of error without any deceptive intent on the part of the applicants, by reason of the fact that we claimed less than we had the right to claim in the original patent.

6. I believe that during prosecution of the application, the attorney handling the prosecution failed to claim aspects of the invention which we are entitled to claim. Claims 1, 6 and 12 of the '240 patent are unduly limited in several aspects, and claim 12 lacks certain desirable clarifying language which would effectively broaden the scope of the claim.

7. The invention is directed to a catheter having one or more exchangeable shaft sections, and a method of using the catheter. Claims 1, 6 and 12 have limitations which unnecessarily limit the scope of the invention claimed.

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8. Claims 1 and 6 of the '240 patent are now unnecessarily limited to a catheter with an exchangeable shaft section and claim 12 is limited to a replaceable distal shaft section, whereas the invention disclosed in the patent includes exchangeable distal and proximal shaft sections.

9. Claim 6 has limitations which unnecessarily limit the scope of the invention claimed. Claim 6 now is limited to a dilatation catheter, whereas the catheter construction disclosed in the patent and contemplated by the invention is more broadly directed to an intravascular catheter.

10. Claim 12 has limitations which may unnecessarily limit the scope of the invention claimed. Claim 12 now is limited to treating a patient's body lumen, whereas the method disclosed in the patent is more broadly directed to a method of performing a medical procedure. Claim 12 requires removing the replaceable distal shaft section, and connecting a replacement distal shaft section to the proximal shaft section. The method disclosed in the patent broadly involved separating connected shaft sections and does not require connecting a replacement distal shaft section.

11. Claim 12 lacks clarifying language, namely, that the catheter is slid on and off a guidewire while the guidewire is restrained, and that the whole catheter is not withdrawn from the patient before the catheter shaft sections are separated.

12. On information and belief, the attorney handling the prosecution of the original application, Edward J. Lynch, through error without deceptive intent, failed to recognize the above described features of the invention in their broadest sense.

13. I am unaware how or when the error occurred but, on information and belief I believe that it occurred during the prosecution of the original application.

14. On information and belief, Edward J. Lynch, undertook a review of the '240 patent during the first quarter of 1997 and, as a result of his review, he concluded that he did not appreciate the breadth of the invention when he was prosecuting the original application.

15. On information and belief, as a result of Mr. Lynch's review, he recommended to the assignee, Advanced Cardiovascular Systems, Inc., that a reissue application be filed for the '240 patent within two years from the issue date thereof, so that the invention thereof could be claimed more broadly.

16. I have reviewed the new claims 24-28 which are included with the present reissue application as filed and new claims 29 and 30 which are presented by preliminary amendment, copies of which are attached hereto as Exhibit B, and believe that we were entitled to claim the invention set forth in these claims 24-30 at the time the original application for the above-referenced patent was made.

17. I hereby appoint the following attorneys and agents to prosecute this reissue application and to transact all business in the United States Patent and Trademark Office connected therewith:

EDWARD J. LYNCH, Registration No. 24,422  
ALAN M. KRUBINER, Registration No. 26,289  
WILLIAM SCHMONSEES, Registration No. 31,796  
JACQUES DULIN, Registration No. 24,067  
HERWIG von MORZE, Registration No. 29,484  
WALTER KURZ, Registration No. 37,373  
DEREK P. FREYBERG, Registration No. 29,250  
PING CHOW, Registration No. 30,740  
ROBERT DENNIS, Registration No. 40,988

of the firm

HELLER EHRMAN WHITE & McAULIFFE  
525 University Avenue  
Palo Alto, CA 94301-1900  
(650) 324-7000

and

COLIN D. BARNITZ, Registration No. 35,061  
WILLIAM A. BLAKE, Registration No. 30,548  
GEORGE M. COOPER, Registration No. 20,201  
FELIX J. D'AMBROSIO, Registration No. 25,721  
DOUGLAS R. HANSCOM, Registration No. 26,600  
JIM W. HELLWEGE, Registration No. 28,808  
ERIC S. SPECTOR, Registration No. 22,495

of the firm:

JONES, TULLAR & COOPER, P.C.  
2001 Jefferson Davis Highway  
Box 2266, EADS Station  
Arlington, VA 22202  
Telephone: (703) 415-1500

Direct all correspondence to:

**Edward J. Lynch**  
HELLER EHRMAN WHITE & McAULIFFE  
525 University Avenue  
Palo Alto, CA 94301-1900  
Tel. No.: (650) 324-7000  
Direct Dial: (650) 324-7098  
Facsimile: (650) 324-0638

I hereby declare that all statements made herein of my own knowledge  
are true and that all statements made on information and belief are believed to be  
true; and further that these statements were made with the knowledge that willful

false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of First Inventor: Celso S. J. Bagaoisan

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature: \_\_\_\_\_

Residence: 4441 Pomponi Street, Union City, California 94587

Post Office Address: same as above

Citizenship: United States of America

Full name of Second Inventor: John P. Shanahan

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature: \_\_\_\_\_

Residence: 61 Leigh Hill Road, Cobham Surrey, KT112HY, UK

Post Office Address: same as above

Citizenship: United States of America

Full name of Third Inventor: Ketan P. Muni

Executed on 6<sup>th</sup> day of January, 1998

Inventor's Signature: Ketan P. Muni

Residence: 97 Frontier Trail Drive, San Jose, CA 95136

Post Office Address: same as above

Citizenship: India U.S.A.

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Full name of Fourth Inventor: Elizabeth N. Hammack

Executed on \_\_\_ day of \_\_\_, 19\_\_.

Inventor's Signature

Residence: 12781 W. Sunset Hills Drive, Los Altos Hills, CA 94022

Post Office Address: same as above

Citizenship: United States of America

Full name of Fifth Inventor: Robert M. Abrams

Executed on \_\_\_ day of \_\_\_, 19\_\_.

Inventor's Signature:

Residence: 359 Redondo Terrace, Sunnyvale, CA 94086

Post Office Address: same as above

Citizenship: United States of America

Full name of Sixth Inventor: James C. Peacock, III

Executed on \_\_\_ day of \_\_\_, 19\_\_.

Inventor's Signature:

Residence: 526 East Evelyn Avenue, Sunnyvale, CA 94086

Post Office Address: same as above

Citizenship: United States of America

Full name of Seventh Inventor: William S. Tremulis

Executed on 29 day of January, 1998

Inventor's Signature

Residence: 97 Pelican Lane, Redwood City, CA 94065

Post Office Address: same as above

Citizenship: United States of America

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Full name of Fourth Inventor: Elizabeth N. Hammack

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature

Residence: 12781 W. Sunset Hills Drive, Los Altos Hills, CA 94022

Post Office Address: same as above

Citizenship: United States of America

Full name of Fifth Inventor: Robert M. Abrams

Executed on 6 day of JANUARY, 1998.

Inventor's Signature:

Residence: 359 Redondo Terrace, Sunnyvale, CA 94086

Post Office Address: same as above

Citizenship: United States of America

Full name of Sixth Inventor: James C. Peacock, III

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature:

Residence: 526 East Evelyn Avenue, Sunnyvale, CA 94086

Post Office Address: same as above

Citizenship: United States of America

Full name of Seventh Inventor: William S. Tremulis

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature

Residence: 97 Pelican Lane, Redwood City, CA 94065

Post Office Address: same as above

Citizenship: United States of America

Full name of Fourth Inventor: Elizabeth N. Hammack

Executed on 6 day of January, 1998.

Inventor's Signature

Elizabeth N. Hammack

Residence:

12781 W. Sunset Hills Drive, Los Altos Hills, CA 94022

Post Office Address:

same as above

Citizenship:

United States of America

Full name of Fifth Inventor: Robert M. Abrams

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature:

Residence:

359 Redondo Terrace, Sunnyvale, CA 94086

Post Office Address:

same as above

Citizenship:

United States of America

Full name of Sixth Inventor: James C. Peacock, III

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature:

Residence:

526 East Evelyn Avenue, Sunnyvale, CA 94086

Post Office Address:

same as above

Citizenship:

United States of America

Full name of Seventh Inventor: William S. Tremulis

Executed on \_\_\_ day of \_\_\_\_\_, 19\_\_.

Inventor's Signature

Residence:

97 Pelican Lane, Redwood City, CA 94065

Post Office Address:

same as above

Citizenship:

United States of America

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In re Reissue Application for U.S.	) Examiner: Not yet assigned
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Patent No.: 5,498,240	) Group Art Unit: 3306
Issued: September 10, 1996	)
	) Docket No.: 22965-2111
Inventors: Bagaoisan et al.	)
	)
Serial No.: 08/843,711	)
Filed: April 16, 1997	)
	)
For: <b>INTRAVASCULAR CATHETER WITH</b>	)
<b>A REPLACEABLE SHAFT SECTION</b>	)

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**PETITION FOR FILING BY OTHER THAN ALL  
INVENTORS PURSUANT TO 37 C.F.R. § 1.47(a)**

BOX MISSING PARTS  
Assistant Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Dear Sir:

Applicant hereby petitions for acceptance of the declarations of signing joint inventors Ketan P. Muni, Elizabeth N. Hammack, Robert M. Abrams, and William S. Tremulis on behalf of all joint inventors: Celso S. J. Bagaoisan, John P. Shanahan, Ketan P. Muni, Elizabeth N. Hammack, Robert M. Abrams, James C. Peacock III, and William S. Tremulis, with the aforementioned signing joint inventors declaring on behalf of the non-signing inventors pursuant to MPEP 409.03(a). This petition is made for the reason that after diligent effort to obtain the declarations of Celso S. J. Bagaoisan, John P. Shanahan, and James C. Peacock III, counsel for applicants was unable to obtain said declarations. On various dates from January 5, 1998 to January 7, 1998, assistant to applicant's counsel, Nita J. Miller, forwarded by Federal Express a request for declaration to all joint inventors at their respective last know addresses. As of the time of the filing of this petition, no response has been received from the non-signing joint inventors, Celso S. J. Bagaoisan, John P. Shanahan, and James C. Peacock III. Filed with and in support of this petition is the declaration of Nita J. Miller regarding the facts

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surrounding the unavailability of the aforementioned inventors, and a list of the last known addresses of the unavailable inventors below.


Last known addresses and telephone numbers of non-signing joint inventors:

Celso S. J. Bagaoisan  
4441 Pomponi Street  
Union City, California 94587  
(510) 471-0747

John P. Shanahan  
1530 Barn Owl Place  
Santa Rosa, CA 95409  
(707) 579-2620

James C. Peacock, III  
526 East Evelyn Avenue  
Sunnyvale, CA 94086  
(408) 245-9427

Respectfully submitted,

By:   
William B. Anderson  
Attorney for Applicants  
Registration No. P41,585

HELLER EHRMAN WHITE & McAULIFFE  
525 University Avenue  
Palo Alto, CA 94301-1900  
Direct Dial: (650) 324-7127  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

WBA:njm

HEWM #65074

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application for U.S.	)	Examiner: Not yet assigned
	)	
Patent No.: 5,498,240	)	Group Art Unit: 3306
Issued: September 10, 1996	)	
	)	Docket No.: 22965-2111
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	)	
Serial No.: 08/843,711	)	
Filed: April 16, 1997	)	
	)	
For: INTRAVASCULAR CATHETER	)	
WITH A REPLACEABLE SHAFT SECTION	)	

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**DECLARATION OF NITA J. MILLER IN SUPPORT OF PETITION FOR FILING BY  
OTHER THAN ALL INVENTORS PURSUANT TO 37 C.F.R. § 1.47(e)**

## BOX MISSING PARTS

Assistant Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Dear Sir:

I, Nita J. Miller, depose and say that:

1. I have been a Patent Assistant to Edward J. Lynch, Applicants' Attorney, with HELLER EHRMAN WHITE & McAULIFFE since July 1997. However, I have been employed as a Patent Assistant since October 1991.

2. On January 5, 1998, I forwarded a letter to James C. Peacock, III, via Federal Express, to 526 East Evelyn Avenue, Sunnyvale, CA 94086. I enclosed therewith a Declaration and Power of Attorney for his signature in connection with the above-referenced matter, and a return self-addressed, postage prepaid Federal Express envelope. A copy of said letter is attached hereto as Exhibit A. On January 29, 1998, I telephoned James Peacock, III at his residence (408) 245-9427, however, his listed telephone number was being forwarded to a facsimile machine. On January 29, 1998, I sent a facsimile message to James C. Peacock, III, at (408) 245-9427, requesting that he send to me via facsimile the signature page of the Declaration and Power of Attorney or that he contact me immediately. A copy of said facsimile message

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together with a copy of the confirmation of transmission attached hereto as Exhibit

A. To date, I have not received a response of any kind.

3. On January 5, 1998, I forwarded a letter to Celso S.J. Bagaoisan, via Federal Express, to 4441 Pomponi Street, Union City, CA 94587. I enclosed therewith a Declaration and Power of Attorney for his signature in connection with the above-referenced application, and a return self-addressed, postage prepaid Federal Express envelope. A copy of said letter is attached hereto as Exhibit B. On January 29, 1998, I left a voice message for Celso S.J. Bagaoisan at his residence telephone (510) 471-0747. To date, I have not received a response of any kind.

4. On January 7, 1998, I forwarded a letter to John P. Shanahan, via Federal Express, to 1530 Barn Owl Place, Santa Rosa, CA 95409. I enclosed therewith a Declaration and Power of Attorney for his signature in connection with the above-referenced application, and a return self-addressed, postage prepaid Federal Express envelope. A copy of said letter is attached hereto as Exhibit C. On January 29, 1998, I telephoned John P. Shanahan at his residence (707) 579-2620, and there was no answer. To date, I have not received a response of any kind.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of this application or any reissue patent issued thereon.

Executed this 29th day of January, 1998, at Palo Alto, California

By: Nita J. Miller

Nita J. Miller